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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,725	01/22/2001	Egbert Jux	CL/V-30578A	1309

1095 7590 10/14/2003

THOMAS HOXIE  
NOVARTIS, CORPORATE INTELLECTUAL PROPERTY  
ONE HEALTH PLAZA 430/2  
EAST HANOVER, NJ 07936-1080

EXAMINER

ANGEBRANNDT, MARTIN J

ART UNIT	PAPER NUMBER
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1756

DATE MAILED: 10/14/2003

62

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicati n N .

09/766,725

Applicant(s)

JUX ET AL.

Examiner

Martin J Angebranndt

Art Unit

1756

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 and 22-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 22-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Art Unit: 1756

1. The response of the applicant has been read and given careful consideration. Response to the amendment and accompanying arguments are presented after the first rejection to which they are directed. The examiner appreciates the translation provided by the applicant. Rejections of the previous office action not found below are withdrawn based upon the amendment and arguments of the applicant.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 1-16 and 22-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, please insert - - marks- - after "step of creating" to make the antecedent basis clear.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-10,13 and 15-16 rejected under 35 U.S.C. 103(a) as being unpatentable over Kiyosaki JP 08-047784 , in view of Edwards et al. '059.

Kiyosaki JP 08-047784 (note machine translation) shows marked blister packs in figures 3 and 4. These are marked as part of the continuous process disclosed with respect to figure 2. The carbon dioxide laser and marking optics are shown as 11 and 12 in figure 2. The use of a laser to remove a portion of an ink layer in section [0004]. The PVC (polyvinyl chloride, a

Art Unit: 1756

plastic) is discolored by the CO<sub>2</sub> laser irradiation and each pocket of the blister pack is marked. [0011]. The apparatus "8" punches out each of the separate groups. The apparatus "6" seals the packaging. These are shown in figures 3 and 4 as two columns of 5 tablets. Each if the columns is considered as strip. The blister pack is a laminate as the blister is formed between two layers. Apparatus 10 marks the packages after they are sealed by apparatus 6. The use of either PVC or polypropylene and the use of discoloration or simple recessing as the marks is disclosed. [0005].

Edwards et al. '059 teaches the packaging of contact lenses in blister packs. (5/58-6/2 and 3/6-20). The structure comprises an outer plastic layer bonded to an aluminum or other foil which is bonded to the base containing the depressions and the contact lenses. The use of two rows with five recesses each is disclosed. (6/13-26).

It would have been obvious to one skilled in the art to use known methods for marking blister packs in a on-line/continuous process taught by Kiyosaki JP 08-047784 with blister packs containing contact lenses, such as taught by Edwards et al. '059 with a reasonable expectation of successfully marking the packaging.

The applicant argues that the Kiyosaki JP 08-047784 reference only uses PVC. The reference describes these as conventional materials (plastics) used in forming blister packs and there is no teachings of a different material plastic in Edwards et al. '059, therefore there is no divergence in the teachings as the use of PVC as the plastic would be embraced by the claims. The claims embrace causing a color change or removing material as evidenced by claim 1. The combination of the references, particularly the passages [0003-0004] of Kiyosaki JP 08-047784 specifically teach away from using sublimation/transfer of inks or conventional printing. As this is appreciated in the prior art, there is no issue of hindsight in recognizing the advantage of laser

Art Unit: 1756

marking by the examiner as it was in the public domain. This also factually precludes the acceptance of the assertion by the applicant that they were the first to recognize these benefits.

The Kiyosaki JP 08-047784 reference teaches marking after sealing and therefore Edwards needs not show this as the rejection is based upon both references, not either of them alone. The rejection stands.

6. Claims 1-13 and 15-16 rejected under 35 U.S.C. 103(a) as being unpatentable over Kiyosaki JP 08-047784 , in view of Edwards et al. '059 and Roy '771.

Roy '771 teaches that carbon dioxide lasers, and YAG laser are known to be useful in laser marking (3/36-51). The energy, wavelength and laser spot size are disclosed. (5/51-62 and table 1.) The laser spot size is equivalent to the hole size.

In addition to the basis provided above, Roy '771 teaches the equivalence of carbon dioxide and Nd-YAG lasers in laser marking processes as well as the size of width of the markings which is the same as the laser beam and the examiner holds that it would have been obvious to one of ordinary skill in the art to modify the invention of the combination of Kiyosaki JP 08-047784 and Edwards et al. '059 by using other lasers and/or laser spot sizes, such as those taught by Roy '771 based upon the disclosure of equivalence within that reference.

The applicant argues that the Kiyosaki JP 08-047784 teaches away from "solid lasers" in general. The examiner agrees, but notes that no specific laser is disclosed as a solid laser. Further, the equivalence of carbon dioxide lasers and YAG lasers is specifically established for marking pharmaceuticals by Roy '771. The rejection stands.

7. Claims 1-16 rejected under 35 U.S.C. 103(a) as being unpatentable over Kiyosaki JP 08-047784 , in view of Edwards et al. '059 and Roy '771, further in view of Bornfleth et al. '683

Art Unit: 1756

Bornfleth et al. '683 establishes that within the manufacturing field, it is old and well known that closely adjacent processing lines allow a single attendant to monitor several of them simultaneously.

In addition to the basis provided above, the examiner holds that it would have been obvious to one of ordinary skill in the art to modify the invention of the combination of Kiyosaki JP 08-047784, Edwards et al. '059 and Roy '771 by running plural lines adjacent to one another to save on personnel costs as disclosed by Bornfleth et al. '683.

As the arguments are the same as above, the response provided above is relied upon without further comment. The rejection stands.

8. Claims 1-13, 15-16 and 22-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kiyosaki JP 08-047784, in view of Edwards et al. '059, Roy '771 and Kim et al. '878

Kim et al. '878 teach that the polymeric (plastic) sheet may be colored or not. (8/57-61). Various thermoplastic polymers, including PVC and polypropylene are disclosed. (3/7-40). The use of aluminum foil backing is also disclosed. (8/46-57)

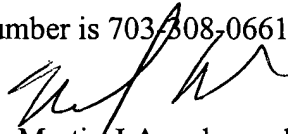
In addition to the basis provided above, the use of either colored or uncolored plastics is considered obvious based upon the disclosure of Kim et al. '878. The use of the colorant makes no difference to the marking as the polymer itself absorbs the laser in Kiyosaki JP 08-047784, but the addition of a colorant could increase the spectral absorption properties of the film to allow the use of other lasers, such as Nd-YAG lasers..

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin J Angebrannndt whose telephone number is 703-308-4397. The examiner can normally be reached on Mondays-Thursday and alternate Fridays.

Art Unit: 1756

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 703-308-2464. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Martin J Angebrannndt  
Primary Examiner  
Art Unit 1756

October 7, 2003